REMARKS

In the Official Action mailed January 26, 2005, the Examiner has rejected all of the claims on different § 103 grounds as being obvious in view of various combinations of references. All of the rejections, however, have included the use of U.S. Patent No. 6,678,462 to Chihara as a primary reference. Namely, claims 31-33, 40-44, 46-49, 51-52, 58-60, 62-65 and 67-72 were rejected under § 103(a) as being unpatentable over Browne et al. in view of Lenihan et al. and further in view of Chihara. Claims 34, 45, 50, 61 and 66 were rejected under § 103(a) as being unpatentable over Brown et al. in view of Lenihan et al. and further in view of Chihara and further in view of Yuen et al. Claims 35-37, 39, 53-55 and 57 were rejected under § 103(a) as being unpatentable over Browne et al. in view of Chihara. Finally, claim 56 was rejected under § 103(a) as being unpatentable over Browne et al. in view of Chihara and further view of Yuen et al.

Elimination Of Chihara As Prior Art In Obviousness Rejections

Applicants note that the present application and Chihara were, at the time the invention of the present application was made, owned by the same entity, namely Sony Corporation of Tokyo, Japan. The assignments of the present application to Sony Corporation have been recorded and can be found at Reel 010971, Frame 0713. Chihara indicates on its front page that it is owned by Sony Corporation. In addition, the assignment of Chihara can be found at Reel 9258, Frame 0921. Accordingly Chihara is disqualified as prior art under 35 U.S.C. § 103(c) as use as a reference in the Examiner's 102(e)/103 rejections of the claims.

* * *

Accordingly, the present claims are deemed to be allowable over the prior art of record usable against the present application. Moreover, even if Chihara was deemed to be

proper prior art, Applicants submit that the presently claimed invention is not rendered obvious by any combination of cited references, including Chihara. Simply put, there is no teaching, suggestion or motivation to combine the references to piece together Applicants' claimed invention, which addresses the issue and problem of user confusion that results from systems that allow the recording and playback of programs in different recording modes that are not compatible, such as digital or analog recording modes, different satellite broadcasting modes, or different compression modes. As such, the prior art is believed to have been combined in hindsight to reconstruct the present invention in an impermissible manner.

In any event, Applicants believe that all of the presently pending claims remain patentable over the prior art of record, and respectfully request the Examiner to issue a Notice of Allowance of all pending clams.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: April 21, 2005

Respectfully submitted,

By _____

Jonathan A. David
Registration No.: 36,494
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicants